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EXAMINER

CHEUNG, MARY DA ZHI WANG

ART UNIT

PAPER NUMBER

3621

DATE MAILED: 07/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/029,160

Applicant(s)

EDENS ET AL.

Examiner

Mary Cheung

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of the Claims

1. This action is in response to the amendment filed on May 9, 2005. Claims 1 and 3-14 are pending. Claims 1 and 3-14 are amended. Claim 2 is canceled.

Response to Arguments

2. Applicant's arguments filed May 9, 2005 have been fully considered but they are not persuasive.

In response to the applicant's arguments that Hart (U. S. Patent 6,714,835) fails to teach a sensor which senses and registers a physical postal item, scanning and registering a property from a physical postal item, and extracting an registering a property from a physical postal item, examiner believes that Hart teaches detecting and setting-up mails (column 3 lines 4-16 and column 4 lines 5-36) that correspond to this limitation.

In response to the applicant's arguments that Hart fails to teach a setting phase in which at least one reference code and at least one setting code are input and are stored in a memory in a mutual coupled relationship, examiner respectfully disagrees because Hart teaches set-up parameters such as Job ID for mails which corresponds to the applicant's reference code (column 4 lines 6-15), and the mailing control files stored in the database which corresponds to the setting code, and matching Job ID with the mailing control file which corresponds to mutually coupled relationship as claimed by the applicant.

Claim Objections

3. Claim 3 is objected to because of the following informalities: in line 9, the phrase "the at least property one item-type property" should be "the at least one item-type property". Appropriate correction is required.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1 and 3-11 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, claims 1 and 3-11 only recite an abstract idea. The recited steps of merely assembling mail pieces does not apply, involve, use, or advance the technological arts since all of the recited steps **can be performed in the mind of the**

Art Unit: 3621

user or by use of a pencil and paper. These steps only constitute an idea of how to assemble mail pieces over another.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed invention assembles mail pieces (i.e., useful, concrete and tangible).

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claims 1-11 are deemed to be directed to non-statutory subject matter.

Applicant is advised to implement computer technologies in the claims, such as change the phrase "generating a code..." to "electronically generating a code...", change the phrase "comparing said code ..." to "electronically comparing said code...", etc.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1, 3-10 and 12-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Hart, Jr. et al., U. S. Patent 6,714,835.

As to claims 1 and 12, Hart teaches a method for machine-producing a series of mail pieces using a system for assembling mail pieces, comprising a start-up phase,

Art Unit: 3621

setting phase and an operating phrase, and a computer-readable storage media carrying a computer readable computer program for setting a system for producing mail pieces, comprising (abstract):

- a) said setting phase comprising the step of:
 - i) inputting at least one reference code representing at least one item-type property of physical, postal items of a particular type (column 4 lines 6-15, 59-65 and Figs. 1, 3B);
 - ii) inputting at least one setting code representing at least one system setting (column 4 lines 6-15, 59-65 and column 5 lines 18-26 and Figs. 1, 3B); and
 - iii) the system storing said reference code and said setting code in a memory in mutually coupled relationship (column 4 lines 6-15, 59-65 and Figs. 1, 3B);
- b) the system during said start-up phase:
 - i) scanning and registering at least one property of at least one physical, postal item (column 3 lines 4-16, 67 – column 4 line 4 and column 4 lines 25-36 and Figs. 3A, 3C);
 - ii) generating a code representing the at least one registered property (column 5 lines 13-17 and Figs. 3A-3B, 4; *specifically, this limitation corresponds to the job ID of the header 82 in Hart's teaching*);
 - iii) comparing said code representing the at least one registered property with the at least one reference code, stored in the memory, which

represents the at least one item-type property (column 5 lines 18-26 and Figs. 2, 3A-3B, 4);

iv) in response to at least a defined extent of agreement between said code representing the at least one registered property and the reference code or at least one of the reference codes, selecting at least one setting code, associated with said reference code or the at least one of the reference codes, which represents a system setting (column 5 lines 18-26 and Fig. 4 *specifically, "selecting at least one setting code" corresponds to input the mailing control file in Hart's teaching*);

c) the operating phase , comprising the steps of:

i. the system producing a series of mailpieces each including at least one of said items of said particular type, in accordance with the selected setting code (column 5 lines 27-53 and Fig. 4).

As to claims 3-4, Hart teaches registering at least one other physical property of the at least one physical postal item, wherein: said generated code represents a combination of the registered properties of the at least one physical postal item (column 5 lines 18-53 and Figs. 2, 3B, 4; *specifically, "at least one other physical property" corresponds to documents, inserts, envelopes, etc. in Hart's teaching, and "codes represents a combination of the registered properties" corresponds to the set-up parameter values that specifying what documents, inserts, envelopes should be used for assembling the mail*); a setting code is selected in response to at least a defined extent of agreement between said generated code and a reference code coupled to said setting code, which reference code represents a combination of the at least item-

type one item-type property of physical, postal items of a particular type and another item-type property of physical, postal items of a particular type (column 5 lines 10-53 and Fig. 4).

As to claim 5, Hart teaches selecting a setting code comprises:

- a) preselecting at least two setting codes each representing a system setting, said setting codes each being coupled to one of the references codes that are at least to a defined extent in agreement with said code generated from the at least one registered property (column 3 line 67 – column 4 line 24 and Fig. 3A-3B; *specifically, “at least two setting codes” corresponds to the plurality of mailpiece records in Hart’s teaching, and “a reference code” corresponds to the Job ID*);
- b) selecting one of said preselected setting codes (column 5 lines 13-27 and Fig. 4).

As to claim 6, Hart teaches representing said preselected setting codes, or said system settings represented thereby, in humanly perceptible form; wherein selecting one of said preselected setting codes includes inputting a choice from said represented setting codes or said system settings represented thereby (column 3 line 67 – column 4 line 36 and Figs. 3A-4).

As to claim 7, Hart teaches the selection of one of said preselected setting codes depends on agreement between system settings represented by said preselected setting codes and a current system setting (column 5 lines 13-53 and Fig. 4).

As to claim 8, Hart teaches the selection of one of said preselected setting codes depends on agreements between item types associated with system settings

Art Unit: 3621

represented by said preselected setting codes and types of the physical postal items present in the system (column 5 lines 13-53 and Fig. 4).

As to claim 9, Hart teaches the registering of the at least property carried out in the area of a feeder station of the system (column 4 lines 5-11 and column 5 lines 41-53).

As to claim 10, Hart teaches determining a difference between a current loading condition of the system for assembling mail pieces and a required loading condition for assembling mail pieces in accordance with said system setting associated with said at least one selected setting code, and signaling an indication associated with said difference (column 5 lines 41-53).

As to claim 13, Hart teaches a system for producing a series of mail pieces comprising (abstract):

- a) at least one station for processing postal items into a mail piece (abstract and Fig. 2);
- b) a sensor, for sensing and registering at least one property of at least one physical postal item (abstract and column 3 lines 5-16 and 67 – column 4 line 4 and column 4 lines 25-36 and Figs. 1-2, 3A, 3C);
- c) a control structure communicatively linked with said sensor for receiving signals from said sensor, which signals represent the at least one property of the at least one physical postal item (abstract and column 5 lines 28-53 and Fig. 2);
- d) a memory for storing at least one reference code representing at least one item-type property of physical, postal items of a particular type and at least one setting code representing a system setting associated with said reference code,

which memory is communicatively linked with said control structure (column 4 lines 5-15 and column 5 lines 18-26 and Figs. 2, 3A-3B, 4);

e) wherein the control structure is arranged for:

- i) said setting phrase: receiving at least one inputted reference code representing at least one item-type property of physical, postal items of a particular type; receiving at least one inputted setting code representing at least one system setting; and storing said reference code and said setting code in a memory in mutually coupled relationship (column 4 lines 6-15, 59-65 and Figs. 1, 3B);
- ii) during a start-up phase following said setting phrase: comparing the signals from the sensor with said reference code or reference codes stored in the memory, and in response to at least a defined extent of agreement between the signals from the sensor and the reference code or at least one of the reference codes, selecting at least one setting code, associated with said reference code or at least one of the reference codes, which represents a system setting (column 5 lines 18-26 and Fig. 4); and
- iii) during an operating phase following said start-up phase: causing said at least one station to produce a series of mailpieces, each including at least one of said items of said item type, with the system set in accordance with the selected setting code (column 5 lines 27-53 and Fig. 4).

As to claim 14, Hart teaches at least one feeder station for feeding postal items, wherein said sensor for registering said at least one property is located in the area of said feeder station (abstract and column 4 lines 5-11 and column 5 lines 41-53).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hart, Jr. et al., U. S. Patent 6,714,835 in view of Breese et al., U. S. Patent 6,353,813.

As to claim 11, Hart teaches determining at least two differences between a current loading condition of the system for assembling mail pieces and at least two loading conditions for assembling mail pieces in accordance with at least two of said system settings associated with at least two of said selected setting codes (column 3 line 67 – column 5 line 53 and Figs. 3A-4).

Hart does not specifically teach determining a smallest one of said at least two differences, and selecting as first setting code, one of said at least two selected setting codes that belongs to the one of the system setting for which the difference between the required loading condition and the current loading condition of the system for assembling mail pieces is the smallest. However, Breese teaches determining a better match to common attributes (abstract and column 7 lines 34-37 and column 8 lines 34-49). It would have been obvious to one of ordinary skill in the art at the time the

Art Unit: 3621

invention was made to allow the different settings in Hart's teaching to include the feature of determining a better match as taught by Breese for helping the operator determine better settings. Furthermore, it would have been obvious to one of ordinary skill in the art to allow the teaching of Hart modified by Breese to include the feature of determining and selecting the settings that is more close to a predetermined setting for better assisting the operator to choose better settings.

Conclusion

10. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Inquire

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Cheung whose telephone number is (571)-272-6705. The examiner can normally be reached on Monday – Thursday from 10:00 AM to 7:00 PM.

Art Unit: 3621

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell, can be reached on (571) 272-6712.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

The fax phone number for the organization where this application or proceedings is assigned are as follows:

(571) 273-8300 (Official Communications; including After Final
Communications labeled "BOX AF")

(571) 273-6705 (Draft Communications)

Mary Cheung
Primary Examiner
Art Unit 3621
July 14, 2005


MARY D. CHEUNG
PRIMARY EXAMINER